

Docket No. 0042-0483P

Appl. No.: 10/618,686

Art Unit: 1731

Amendment dated November 3, 2004

Reply to Office Action of June 3, 2004

Page 4 of 11

REMARKS

Applicants appreciate the Examiner's thorough consideration provided in the present application. Claims 1-7 are currently pending in the instant application. Claims 1 and 2 have been amended and claims 3-7 have been added. The subject matter of additional claims 3-7 is fully supported by the original written description, including, but not limited to FIGs. 3-6 and the corresponding description in the specification. Claim 1 is independent. Reconsideration of the present application is earnestly solicited.

Priority

Applicants appreciate the Examiner's indication of acceptance of the certified copy of the corresponding priority document for the present application.

Drawings

Applicants would appreciate the Examiner's indication of acceptance of the formal drawings filed on July 15, 2003.

Claim Rejection Under 35 U.S.C. § 102

Claims 1-2 have been rejected under 35 U.S.C. § 102(b) or 35 U.S.C. § 103(a) as being either anticipated by or obvious over Case et al. (U.S. Patent No. 6,000,404). These rejections are respectfully traversed.

In light of the foregoing amendments to the claims, Applicants submit that this rejection has been obviated and/or rendered moot. Without conceding the propriety of the Examiner's rejections, but merely to expedite the prosecution of the present application, Applicants have amended claim 1 to clarify the claimed invention for the benefit of the Examiner. However, Applicants submit that claim 1 has been amended to merely explicitly state those features implicitly claimed in original claim 1. Accordingly, this rejection should be withdrawn.

For example, Applicants submit that the prior art of record fails to teach or suggest each and every limitation of the unique combination of limitations of the claimed invention, including the feature(s) of: "said wrapping material wrapping an outer circumferential surface of the columnar tobacco filler material, wherein said wrapping paper sheet includes an outermost wrapping paper sheet having a thermal conductivity of $0.5 \text{ W}\cdot\text{K}^{-1}\cdot\text{m}^{-1}$ or more; and an inside wrapping paper sheet between said outermost wrapping paper sheet and said filler material." Accordingly, this rejection should be withdrawn.

Docket No. 0042-0483P

Appl. No.: 10/618,686

Art Unit: 1731

Amendment dated November 3, 2004

Reply to Office Action of June 3, 2004

Page 6 of 11

The Examiner has admitted that Case et al. fails to teach or suggest a wrapping paper sheet including an outermost wrapping paper sheet having a thermal conductivity of 0.5 W·K⁻¹·m⁻¹ or more. Further, Applicants submit that the Examiner's insinuation that Applicants' own specification teaches or suggests that Case et al. inherently includes this feature is improper. Specifically, Applicants submit that Table 1 does not indicate that Case et al. inherently includes a thermal conductivity of 0.5 W·K⁻¹·m⁻¹ or more. Accordingly, this rejection should be withdrawn.

However, in order to expedite the prosecution of the present application, Applicants have voluntarily amended claim 1 to include the additional feature of "an inside wrapping paper sheet between said outermost wrapping paper sheet and said filler material." Applicants submit that this unique combination of limitations is clearly not taught or suggested by the prior art of record.

Claim Rejection Under 35 U.S.C. § 103

Claim 1 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Drewett et al. (U.S. Patent No. 5,105,835). Claim 1 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over Milkovic et al. (DE 42 02 750 A1- English Abstract provided by Examiner). These rejections are respectfully traversed.

Docket No. 0042-0483P

Appl. No.: 10/618,686

Art Unit: 1731

Amendment dated November 3, 2004

Reply to Office Action of June 3, 2004

Page 7 of 11

As discussed in greater detail hereinabove with respect to claim 1, Applicants submit that the prior art of record fails to teach or suggest each and every limitation of the unique combination of limitations of the claimed invention, including the feature(s) of: "said wrapping material wrapping an outer circumferential surface of the columnar tobacco filler material, wherein said wrapping paper sheet includes an outermost wrapping paper sheet having a thermal conductivity of $0.5 \text{ W}\cdot\text{K}^{-1}\cdot\text{m}^{-1}$ or more; and an inside wrapping paper sheet between said outermost wrapping paper sheet and said filler material." Accordingly, this rejection should be withdrawn.

The Examiner has alleged that Drewitt et al. and/or Milkovic et al. implicitly suggest the feature of a wrapping paper sheet having a thermal conductivity of $0.5 \text{ W}\cdot\text{K}^{-1}\cdot\text{m}^{-1}$. Specifically, although these references do not explicitly recite this thermal conductivity value, the Examiner has alleged that one of ordinary skill in the art would have obtained a thermal conductivity value of $0.5 \text{ W}\cdot\text{K}^{-1}\cdot\text{m}^{-1}$ by routine experimentation after considering the teachings of these references. This interpretation is respectfully traversed.

Applicants submit that it is improper to allege that either of these references would have been modified to include an outermost paper wrapping sheet having this explicit thermal conductivity without citing additional references to support the Examiner's opinion. Accordingly, the Examiner si

requested to provide actual evidence from secondary references to support the Examiner's opinions that one of ordinary skill in the art would have been motivated to alter the Drewett et al. or Milkovic et al. smoking articles to include an outermost paper wrapping sheet having the explicit thermal conductivity of the claimed invention. For example, Applicants submit that the Examiner has not identified any particular, art-recognized problem being addressed by the modification of Drewett et al. or Milkovic et al. Accordingly, Applicants submit that without the teachings of Applicants own specification, one of ordinary skill in the art would not have any reason to modify the thermal conductivity of an outermost paper wrapping sheet in these two references to any value. Therefore, the explicit thermal conductivity of the claimed invention would clearly not have been obvious to achieve by routine experimentation.

Applicants respectfully submit that the Examiner has made several assumptions that are not supported by the prior art of record and are therefore improper. First, the prior art of record does not teach or suggest any problems with the Case, Drewett or Milkovic patents that would require modification of a thermal conductivity value. Second, none of these references teach or suggest any beneficial result of an outermost paper wrapping sheet having a thermal conductivity of 0.5 W·K⁻¹·m⁻¹ or more. Therefore, one of ordinary skill in the art would not have been motivated to experiment in the first place unless there

Docket No. 0042-0483P

Appl. No.: 10/618,686

Art Unit: 1731

Amendment dated November 3, 2004

Reply to Office Action of June 3, 2004

Page 9 of 11

were some art recognized problem which the skilled artisan were attempting to overcome. Since the Examiner has not identified any teachings in the prior art of record to support these opinions, Applicants submit that this rejection is improper and should be withdrawn.

As described hereinabove, Applicants have also amended claim 1 to include the features of "an inside wrapping paper sheet between said outermost wrapping paper sheet and said filler material." Applicants submit that this unique combination of limitations is clearly not taught or suggested by the prior art of record. Accordingly, these rejections should be withdrawn.

In accordance with the above discussion of the patents relied upon by the Examiner, Applicants respectfully submit that these documents, either in combination together or standing alone, fail to teach or suggest the invention as is set forth by the claims of the instant application.

As to the dependent claims, Applicants respectfully submit that these claims are allowable due to their dependence upon an allowable independent claim, as well as for additional limitations provided by these claims.

Docket No. 0042-0483P

Appl. No.: 10/618,686

Art Unit: 1731

Amendment dated November 3, 2004

Reply to Office Action of June 3, 2004

Page 10 of 11

CONCLUSION

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but merely to show the state-of-the-art, no further comments are deemed necessary with respect thereto.

All the stated grounds of rejection have been properly traversed and/or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently pending rejections and that they be withdrawn.

In the event there are any matters remaining in this application, the Examiner is invited to contact Matthew T. Shanley, Registration No. 47,074 at (703) 205-8000 in the Washington, D.C. area.

Pursuant to 37 C.F.R. §§ 1.17 and 1.136(a), Applicants respectfully petition for a two (2) month extension of time for filing a reply in connection with the present application, and the required fee of \$430.00 is attached hereto.

Docket No. 0042-0483P

Appl. No.: 10/618,686

Art Unit: 1731

Amendment dated November 3, 2004

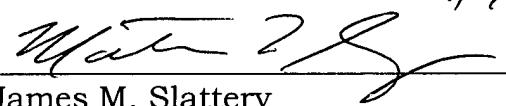
Reply to Office Action of June 3, 2004

Page 11 of 11

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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